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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,037	04/21/2000	Ellia Karres	30012-pa	6483

37095 7590 03/24/2004

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EXAMINER	
LAMB, TWYLER MARIE	

ART UNIT	PAPER NUMBER
2622	7

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/557,037	Applicant(s) KARRES, ELLIA	
	Examiner Twyler M. Lamb	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Notice to Applicant (s)

1. This action is responsive to the following communications: amendment A filed on 12/29/03.

2. This application has been reconsidered. Claims 1-9 are pending.

DETAILED ACTION

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (Angles) (US 5,933,811).

With regard to claims 1 and 2, Angles discloses a system (Figure 1) for the display of advertisements over two communication mediums (col 7, line 45 – col 8, line 7) comprising: sequester means (consumer computer 12) to sequester advertisements in a first format into a second format (col 18, line 61 – col 19, line 3); display means (consumer computer) to display said second format (col 19, lines 1-3); and refresh means (consumer computer 12 containing the "cookie") to refresh the second format

when the first format changes; wherein said refresh means provides commonality in the advertisement between said first format and said second format (col 11, lines 2-49; col 19, lines 28-49).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (Angles) (US 5,933,811) in view Dedrick (US 5,604,542).

With regard to claims 3 and 4, Angles discloses a system (Figure 1) for displaying an advertisement in two distinct communication (col 7, line 45 – col 8, line 7) comprising: an editor means (consumer computer 12) for formulating the advertisement on a tangible medium (col 18, line 61 – col 19, line 3); a file transfer means (content provider computer 14) to transfer the advertisement from said editor means to a universal remote locator (col 19, lines 22-27); and a means (consumer computer 12) to permit access to said universal remote location to view the advertisement from a visual display unit until said advertisement is replaced with a more current advertisement generated from said editor means (col 19, lines 1-3).

Angles differs from claims 3 and 4 in that he does not teach a printing means for producing the advertisement in a paper medium.

Dedrick discloses a system for transmitting an electronic advertisement that includes a printing means (printer 94) for producing the advertisement in a paper medium (col 3, lines 40-41).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Angles to include a printing means for producing the advertisement in a paper medium as taught by Dedrick. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified by the teaching of Dedrick so that the advertisement could be printed out as taught by Dedrick in col 3, lines 40-41.

With regard to claim 5, Angles does not teach further including the step of: replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between the printed advertisement and the electronic advertisement.

Dedrick discloses a system for transmitting an electronic advertisement that includes further including the step of: replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between the printed advertisement and the electronic advertisement (which reads on the decoder, server and computer removing the advertisement from the video signal) (col 3, lines 38-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Angles to include replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between

the printed advertisement and the electronic advertisement as taught by Dedrick. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified by the teaching of Dedrick so that the advertisement could be printed out as taught by Dedrick in col 3, lines 40-41.

The limitations for claims 6-9 are addressed above.

Response to Arguments

7. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive.

Applicant argues that Angles does not show two mediums as specified by the claims.

The claim states "sequester means to sequester advertisements existing in a first format into a second format".

Angles discloses a system (Figure 1) for the display of advertisements over two communication mediums (col 7, line 45 – col 8, line 7) comprising: sequester means (consumer computer 12) to sequester advertisements in a first format into a second format (col 18, line 61 – col 19, line 3).

The applicant also argues that Angles nor Derrick reflect the medium of a newspaper.

Since the advertisements can be read from a medium, it is not beyond the scope that the medium be a news paper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington. VA.
Sixth Floor (Receptionist)

Twyler Lamb

March 22, 2004